REMARKS

Favorable reconsideration of this application is respectfully requested in view of the amendments above and the following remarks. Claims 1-35 are pending of which claims 1, 12, 19, 25, 27, and 34 are independent. Claims 25 and 26 have been amended to depend from claim 1.

Figures 2-4 were objected to as allegedly not conforming to 37 CFR 1.121(d).

The Figures were also objected to as allegedly not conforming to 73 CFR 1.84(p)(5).

Claims 12 and 25 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated over 6,839,275 to Van Brocklin et al (Van Brocklin).

Claims 1, 9-11, 19, 25-27, 34 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Van Brocklin in view of 2003/0023922 to Davis et al. (Davis).

These rejections are respectfully traversed for the reasons stated below.

Allowable Subject Matter

Claims 2-8, 13-18, 20-24, and 28-33 were objected as depending from a rejected base claim, but allowable if rewritten in independent form.

Objection to the Drawings

Figures 2-4 were objected to as allegedly not conforming to 37 CFR 1.121(d). Accordingly, Figures 2-4 have been designated by the legend "background art" in the replacement sheets submitted herein.

The Figures were objected to as allegedly not conforming to 73 CFR 1.84(p)(5), because reference numbers "72," "74," and "76" are not present in the Figures. With respect

to reference numbers "72" and "74," the specification has been amended herein to refer to "72a and 72b" and "74a and 74b" in place of "72" and "74," respectively. With respect to reference character "76," the sentence containing this reference character has been deleted.

Therefore, it is respectfully requested that the objection to the drawings be withdrawn.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

> Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 12 and 25 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated over Van Brocklin. This rejection is respectfully traversed because Van Brocklin fails to disclose the all the features of independent claims 12 and 25 and the claims that depend therefrom.

Specifically, claim 25 has been amended herein to depend from claim 1, which is allowable for the reasons set forth below.

With respect to claim 12, Van Brocklin fails to teach or suggest generating "a first compressed fault map," generating a "second compressed fault map" at a different time interval, and comparing the two generated fault maps, as recited in claim 12. The Office Action generally alleges, without providing any specific reasoning, that these features are disclosed by Van Brocklin in column 1, lines 10-67 through column 2, lines 1-40. However, these passages cited in the Office Action describe the basic state of the art with regard to magnetic memory cells. Column 2, lines 20-30 describes how faults in memory cells occur, but makes no mention of generating a fault map. In fact, nowhere in the passages cited in the Office Action is there any mention of the generation of a fault map.

In the event that this rejection is maintained or that Van Brocklin is relied upon in a subsequent rejection, the Applicants respectfully request that the Examiner provide clarification detailing how Van Brocklin is construed as allegedly disclosing the claimed features.

In column 5, lines 25-65, Van Brocklin discloses a fault map. However, Van Brocklin does not teach or suggest generating a first and second fault map. Van Brocklin discloses two maps but only one is a fault map. The other is an address map. Therefore, Van Brocklin fails to teach or suggest generating "a first compressed fault map" and generating a "second compressed fault map" at a different time interval," as recited by claim 12.

Van Brocklin also fails to teach or suggest comparing two generated fault maps. In column 5, lines 45-47, Van Brocklin discloses comparing received data with a pre-stored fault map stored in non-volatile memory 26. This disclosure, however, is not equivalent to

generating two different fault maps and comparing the two generated fault maps, as claim 12 recites because Van Brocklin fails to teach or suggest the received data is a fault map.

Accordingly, Van Brocklin fails to disclose each and every element of independent claim 12. Therefore, withdrawal of this rejection and allowance of the claims is respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 1, 9-11, 19, 25-27, 34 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Van Brocklin in view of Davis.

COMMON OWNERSHIP, MPEP 706.02(I)(2)

The instant application, 10/722,918, and both U.S. Patent number 6,839,275 to Van Brocklin et al. and U.S. Patent Application Publication number 2003/0023933 to Davis et al. were, at the time the invention of the instant application was made, all owned by the Hewlett-Packard Company.

In accordance with the MPEP 706.02(I)(2)(II), this "clear and conspicuous" statement is sufficient to establish that, at the time the invention of the instant application was made, the instant application and the prior art of record were owned by the same entity. Therefore, both Davis and Van Brocklin are disqualified as prior art under 35 USC 103(a) against the claims of the instant application and, thus, the current rejection is invalid.

Accordingly, withdrawal of this rejection and allowance of the claims is respectfully requested.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: December 6, 2006 By

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